

## **RESPONSE**

This is a response to the Office Action dated August 11, 2005. The Examiner has rejected claims 67-91 under 35 U.S.C. § 112, second paragraph, as being indefinite. Claims 49, 52-55, 57-58, 60-66 and 67-91 were rejected under 35 U.S.C. § 101 for non-statutory subject matter. Claims 49-50, 54, 61-64, 66-72, 77, 85-88 and 90-93 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Pat. No. 6,026,368 (“Brown”) in view of U.S. Pub 2005/0010477 (“Sullivan”). Claims 51, 57-59, 60, 65, 73, 81-84, 89 and 94 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Brown in view of Sullivan. Claims 52, 55-56, 74 and 78-80 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Brown in view of Sullivan and further in view of U.S. Pat. No. 6,167,382 (“Sparks”). Claims 53, 75 and 76 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Brown in view of Sullivan and further in view of U.S. Pat. No. 6,253,188 (“Witek”).

The rejections from the Office Action of August 11, 2005 are discussed below. No new matter has been added. Various claims have been amended for clarity and not for reasons related to patentability. Reconsideration of the application is respectfully requested in light of the above amendments and the following remarks.

### **I. REJECTIONS UNDER 35 U.S.C. § 112**

The Examiner has rejected claims 67-91 under 35 U.S.C. § 112, second paragraph, as being indefinite. With this amendment, claim 67 has been amended to more clearly identify what is claimed. In particular, a computer is disclosed comprising “a memory and a processor coupled with the memory, the processor operative to perform instructions stored in the memory, the memory storing a self-serve user interface.” This amendment makes clear that a computer is claimed with a processor and a memory wherein the memory stores a self-serve user interface and the self-serve user interface comprises instructions that are enabled by the processor. This amendment is purely for clarity and is unrelated to patentability. Accordingly, Applicants respectfully request that the Examiner withdraw this rejection of claims 67-91.

### **II. REJECTIONS UNDER 35 U.S.C. § 101**

The Examiner has rejected claims 49, 52-55, 57-58 and 60-66 under 35 U.S.C. § 101 for non-statutory subject matter. The Examiner stated that “the present basis for 35 U.S.C. 101

inquiry is a two-prong test: (1) whether the invention is within the technological arts; and (2) whether the invention produces a useful, concrete, and tangible result.” Office Action of 08/11/05, p. 4. However, the Board of Patent Appeals and Interferences has ruled in a recent precedential opinion that there is no separate technological arts test under § 101. *Ex parte Lundgren*, 76 U.S.P.Q.2d 1385, 1388 (Bd. Pat. App. & Int., Sep. 28, 2005) (reversing the examiner’s 101 rejection). The Board determined that “there is no judicially recognized separate ‘technological arts’ test to determine patent eligible subject matter under § 101.” *Id.* Applicants believe the Examiner’s § 101 rejections are improper in light of the *Lundgren* case.

None-the-less, Applicants have amended independent claim 49 to incorporate a computer, a computer network, and an electronic display in a significant way. The Examiner has rejected claims 67-91 under 35 U.S.C. § 101 for non-statutory subject matter. Applicants note that this rejection is similar to the § 112 rejection discussed above. Applicants have amended claim 67 to claim functional instructions in a computer memory. The instructions are enabled by a processor. Because the instructions are stored in a memory and enabled by a processor, they are embodied in a computer readable media in accordance with MPEP § 2106(IV)(B)(1)(a).

Accordingly, Applicants respectfully request that the 35 U.S.C. § 101 rejections of claims 49, 52-55, 57-58, 60-66 and 67-91 be withdrawn.

### **III. REJECTIONS UNDER 35 U.S.C. § 103(a)**

Claims 49-50, 54, 61-64, 66-72, 77, 85-88 and 90-93 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Brown in view of Sullivan. Applicants submit that these claims are patentable as the cited references, alone or in combination, fail to disclose all of the elements of these claims.

Brown relates to “a targeting system and method that is both interactive and intelligent.” Brown, Summary of the Invention. The system in Brown “will assemble and provide content and advertising information to the network so as to be preferably distributed to a targeted set of viewers.” *Id.* at Field of Invention.

Sullivan relates to a “method of optimizing direct marketing campaigns to a pool of potential donors.” Sullivan, Abstract. Brown does not focus on electronic marketing, but rather deals with sending out mailings. *Id.* at Summary of the Invention. Also, the marketing in Brown is for a donor as opposed to a general consumer. *Id.*

Brown fails to disclose the reviewing of an advertisement using a computer coupled with a computer network, wherein if the advertisement is deemed not approved, the advertisement campaign is rejected as in claims 49, 67 and 92. Brown does disclose an “accounting data manager 332 [that] provides a mechanism for removing records from the exposure accounting storage 320 that have already been used for billing purposes.” Brown, col. 24, ll. 47-50. However, this mechanism does not perform an approval or non-approval of the advertisement. Brown also discloses an authorization of the data sources available to a campaign. Brown, col. 24, ll. 25-33. Further, according to Brown, the data is evaluated based on objectives of the campaign. Brown, col. 24, ll. 53-61. However, neither the authorization of the data sources nor the evaluation of the data as in Brown operate as an approval or non-approval of the advertisement itself, but are merely an analysis of particular data in the advertisement. Sullivan also fails to disclose this feature, focusing instead on optimizing the advertising. *See* Sullivan, Abstract.

The Examiner acknowledges that Brown fails to disclose the accounting of the display based on the maximum amount to spend, such that the advertisement is displayed until the maximum amount to spend is met as in claims 49, 67 and 92. Office Action of Aug. 8, 2005, p. 8-9. However, Sullivan also fails to disclose this feature. Sullivan relates to direct mailing marketing to potential donors. Sullivan, Summary of the Invention. Sullivan does disclose a budget for a segment of the campaign, such that the amount spent on packaging and shipping should not exceed the particular budget of that direct mailing. Sullivan, ¶ 79, FIG. 9. However, this is different from what is claimed in claims 49, 67 and 92, e.g. where the display of the advertisement is accounted for based on the maximum amount to spend and the display is terminated when the maximum amount to spend is met. In particular, Sullivan teaches away from terminating the marketing once the budget amount is reached as Sullivan specifically states that the balance listed may be negative. Sullivan, ¶ 79. Accordingly, the marketing disclosed in Sullivan does not terminate once the maximum amount is reached.

Further, there is no motivation to combine Brown with Sullivan. Brown relates to an on-line system of providing advertising. Brown, Abstract. However, Sullivan does not relate to on-line advertising, but rather relates to a method for analyzing marketing data. Sullivan, Abstract. The advertising disclosed in Sullivan is direct mail marketing. Sullivan, Fig. 1. Sullivan does use a computer database, but that is for the storage of marketing or advertising data, rather than

advertising itself. In addition, Sullivan deals specifically with a direct marketing campaign to request donations. The marketing disclosed is the requesting of donations, rather than advertising a product as in Brown. In addition, the budget discussed in Sullivan relates to the budget for a direct mailing based on the shipping or packing costs of the mailing. Brown relates to on-line advertising. There is no suggestion to combine Brown with Sullivan, and it would not be obvious to one of skill in the art to combine the budget for the direct mailing in Sullivan with the on-line advertising of Brown.

For the reasons described above, Applicants submits that independent claims 49, 67 and 92 are allowable. Likewise, claims dependent from allowable claims 49, 67 and 92 are also allowable. Specifically, dependent claims 51, 57-59, 60, 65, 73, 81-84, 89 and 94 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Brown in view of Sullivan. For the reasons discussed above, Applicants submit that dependent claims 51, 57-59, 60, 65, 73, 81-84, 89 and 94 are allowable.

Claims 52, 55-56, 74 and 78-80 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Brown in view of Sullivan and further in view of Sparks. Sparks relates to advertising, but more specifically, on the creation of advertisements. Sparks, Summary of the Invention. Sparks fails to disclose the reviewing of an advertisement for acceptance and fails to disclose the maximum amount associated with the accounting of the advertisement's display as in independent claims 49 and 67. Therefore, dependent claims 52, 55-56, 74 and 78-80 should be allowed.

Claims 53, 75 and 76 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Brown in view of Sullivan and further in view of Witek. Witek relates to a system of providing classified ads over the Internet. Witek, Abstract. Witek f fails to disclose the reviewing of an advertisement for acceptance and fails to disclose the maximum amount associated with the accounting of the advertisement's display as in independent claims 49 and 67. Therefore, dependent claims 53, 75 and 76 should be allowed.

**IV. CONCLUSION**

Each of the rejections in the Office Action dated August 11, 2005 have been addressed and no new matter has been added. Applicants submit that all of the pending claims are in condition for allowance and notice to this effect is respectfully requested. The Examiner is invited to call the undersigned if it would expedite the prosecution of this application.

Respectfully submitted,

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Date

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